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EXAMINER

JARRETT, SCOTT L

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/705,486

Applicant(s)

GENDLER, JOSEPH

Examiner

Scott L. Jarrett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 68-104 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 68-104 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 November 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/16/2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This non-final office action is in response to Applicant amendment filed March 6, 2006. Applicant's amendment amended claim 101. Currently claims 68-104 are pending.

Response to Amendment

2. The Objection to the Title is withdrawn in response to Applicant's amendment to the Title.

The Objection to Claim 101 is withdrawn in response to Applicant's amendment to Claim 101.

The 35 USC 112(2) rejection of Claim 85 is withdrawn.

Applicant's attempt at traversing the Official Noticed facts is inadequate, see Applicant's remarks filed March 6, 2006 (Paragraph 2, Page 15).

Adequate traversal is a two-step process. First, Applicant's must state their traversal on the record. Second and in accordance with 37 C.F.R. 1.111(b) which requires Applicant's to specifically point out the supposed errors in the Office Action, Applicant's must state why the Official Notice statement(s) are not to be considered common knowledge or well known in the art.

In this application, the Applicant's have failed both steps (1) and (2) since Applicant's failed to state their traversal on the record and failed to argue why the Official Notice statement(s) are not to be considered common knowledge or well known

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in the art. Because Applicant's' traversal is inadequate, the Official Notice statement(s) are taken to be admitted as prior art. See MPEP 2144.03.

Specifically it has been established that it was old and well known in the art at the time of the invention:

- to review/confirm electronic funds transfers wherein the confirmation of payment (disbursement, transfer) is an essential component of electronic funds transfers for without such confirmations the paid party would not be able to confirm receipt of the payment prior to resuming work, providing a product/service or the like;
- to assign project numbers to projects for the purpose of uniquely identifying a project and its related information/documents thereby providing the ability for individuals and systems to differentiate/uniquely identify individual projects for the purposes of reporting, accounting, project management or the like;
- to evaluate bids/extended offers by a vendor (contractor, supplier, etc.) as one step in the bidding process that ultimately leads to the selection/approval/acceptance of a bid/vendor; and
- to enable users to access all project information/documents related to the projects they are assigned to/working on as well as to list projects (deliverables, tasks, etc.) associated with a particular user thereby providing users with a list of projects (activities, processes, etc.) they are associated with and/or responsible for as part of a workflow system/method.

Response to Arguments

3. Applicant's arguments, see Paragraph 2, Page 16, filed March 6, 2006, with respect to the rejection(s) of claim(s) 68-104 under USC 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made below.

Information Disclosure Statement

4. The information disclosure statement filed November 16, 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; *each non-patent literature publication* or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been fully considered.

Specifically the following references were not considered for the following reasons: (1) Illegible - reference nos.: 474-476, 493 and 503; (2) Incomplete reference - reference nos.: 487, 498, 502, 503, 514, 517 and 524 and (3) No translation provided - reference no.: 455.

Further the information disclosure statement filed November 16, 2005 is replete with grammatical and/or typographical errors for example the following reference lines contain multiple references on the same reference line many of which are repeats of earlier listed references: 466-469, 471-472, 476-477, 486-487, 489-490, 497-498, 506-514, 516-517, 519-520, 522-526, 529-530.

Appropriate correction is required.

The information disclosure statement filed November 16, 2005 has been made part of the record in the application; however it is noted that the statement comprises 27 pages and over 500 references, 454 of which are U.S. Patents, wherein a vast majority of the references cited are not relevant to the claimed invention. The applicant is invited to specifically point-out those references that may be pertinent to the claimed invention.

Drawings

5. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because Figures 1-16 are illegible and/or informal. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Objections

6. Claims 99 and 100 are objected to as being identical independent claims. Applicant's should rewrite or cancel one or both of the claims to overcome this objection.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 68-87, 90-91, 93-95 and 97 are rejected under 35 U.S.C. 102(e) as being anticipated by Primavera System, Inc.'s Primavera Expedition system/product as disclosed in at least the following Primavera Expedition Version 6.0 User's Guide (1998), herein after reference A.

Regarding Claim 68 Primavera Expedition teaches a system and method for managing construction projects that provides document repository and workflow subsystems for creating and managing projects and associated project document collections/data sets wherein the project documents (e.g. contracts, purchase orders, change orders, proposals, invoices, bids, requests for proposals, requests for payment, requisitions, submittals, etc.; reference A: Pages ix, 3, 6-8, 10-11, 16, 165, 177-179, 198, 229).

More specifically Primavera Expedition teaches a system and method for managing a project comprising:

- establishing a database maintained by a project management entity
(construction manager, general contract, owner, etc.; reference A: Paragraph 1, Page 6; Paragraph 1, Page 18; Pages 16-18; e.g. Sybase; Bullet 10, Page 10; Pages 93-97);
- providing funding approval associated with the project, the funding approval being effected in association with project documentation contained in the database (e.g. approved revisions/change orders, initial/committed budget, invoice/requisition approval, negotiated, etc.; reference A: "Invoices/Requisitions are generated from contracts/POs, then sent for payment approval. The amounts are posted on the Cost Worksheet to track actual costs", Paragraph 4, Page 6; Paragraph 3, Page 16; "Approving Requisitions: Preparing Requisitions for Payment chapter.", Bullet 6; Page 18; "You can easily track submittal review cycles.... which submittals were approved and which are pending", Paragraph 1, Page 39; Bullets 1-2 and 5, Page 165; "Change management is a workflow process that automatically creates the documents necessary to track a change from the initial request through approval.", Paragraph 1, Page 173; Step 5, Page 199; Paragraph 2, Page 204; Pages 212-213; "Type the date the contract was signed"; figure caption, Page 21; contract acceptance field, figure on Page 37; document status – approved as noted, approved, disapproved, etc., first figure on Page 78; action taken section on transmittal form – approved as submitted, approved as noted, etc.; Page 133);
- accessing the document collection by a vendor (supplier, contractor, partner, general contractors, construction managers, etc.; reference A: "As the general contractor you'll use Expedition to manage shop drawings and submittal items, track

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project issues, document the change process and record daily progress.”, Paragraph 3, Page 16; Pages 16-18; group roles – construction manager, architect, engineer, contractor, subcontractor, supplier, etc.; Paragraph 1, Page 77);

- vendor (contractor, subcontractor, supplier, manufacturer, etc.)

entering/submitting information related to the project electronically (invoices, requisitions, purchase orders, change orders, submittals, etc.; reference A: Pages 177-179, 198; “Requisitions, or formal requests for payment, are usually issued by general contractors to the owner on a monthly basis as portions of the work on a project are completed....an application for payment based on the original requisition is updated, certified and sent.”, Paragraph 1, Page 198; application for payment, second figure on Page 201; “After an application for payment is submitted, the contracting parties negotiate and eventually agree on an amount. The requisition is then certified, and you the contractor can submit it to the owner for payment.”, Paragraph 1, Page 217); and

- vendor determining that funding approval for the project has been secured through access to the document collection (e.g. submit/track submittals, proceed orders, committed, actuals, pending, changes, etc.; reference A: “After participants accept a contract or purchase order and work begins, any changes resulting from changed specifications or changed conditions affect the initial contract.”, Last Paragraph, Page 6; Page 6-8, 163-166, 181; “Funding”, Bullet 5, Page 165; “reviewing contract status”, Page 188; “Requisitions are based on contract or purchase order...parallel industry standard AIA G702/703 certification payment forms....You negotiate the line item or lump sum costs until a payment agreement is reached and the requisition is approved

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and certified.”, Last Paragraph, Page 198; “Depending on your role, you may issue payment requests or receive payment requests. For example, if you are a general contractor you receive payment requisitions from subcontractors and you issue requisitions to owners.”, Paragraph 1, Page 199; Figure, Page 200; “All applicable parties approve the requisition.”, Paragraph 2, Page 204; “Certifying a Requisition”, Page 212).

Regarding Claims 69-70 Primavera Expedition teaches a project management system and method further comprising transferring monetary funds (distributing funds, making payments, paying invoices/requisitions/purchase orders, etc.) to the vendor after a predetermined event has occurred such as the completion of a portion of a project (“schedule of values”, unit prices, lump sum, periodic project payment, etc.; reference A: Pages 178-179, 181, 184-185, 198, 201; “Requisitions, or formal requests for payment, are usually issued by general contractors to the owner on a monthly basis as portions of the work on a project are completed....an application for payment based on the original requisition is updated, certified and sent.”, Paragraph 1, Page 198; second Figure, application for payment, Page 201; Paragraph 1, Page 342).

Regarding Claims 71-72 and 83 Primavera Expedition teaches a project management system and method wherein the vendor submits, electronically, an invoice upon the completion of a portion of the project (reference A: Page 198; Step 5, Pages 199-201, 217, 219-221, 227) as well as obtaining an invoice from each vendor

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(submittals, requisitions, purchase orders, etc.; reference A: Pages 198, 219-225;

“Requisitions, or formal requests for payment, are usually issued by general contractors to the owner on a monthly basis as portions of the work on a project are completed....an application for payment based on the original requisition is updated, certified and sent.”, Paragraph 1, Page 198; second Figure, application for payment, Page 201; “Depending on your role, you may issue payment requests or receive payment requests. For example, if you are a general contractor you receive payment requisitions from subcontractors and you issue requisitions to owners.”, Paragraph 1, Page 199; “Adding Invoices to a Purchase Order”, Paragraphs 1,3, Page 220; “Invoice Reports and Forms”, Page 226).

Regarding Claim 73 Primavera Expedition teaches a project management system and method wherein subsequent to the submission of the vendor invoice a payment goes through a validation (“certification”, verification, etc.) process and is charged against portions of a project contract (e.g. cost distribution; reference A: Pages 37, 198-201, 204, 206, 212-213; “Requisitions, or formal requests for payment, are usually issued by general contractors to the owner on a monthly basis as portions of the work on a project are completed....an application for payment based on the original requisition is updated, certified and sent.”, Paragraph 1, Page 198; second Figure, application for payment, Page 201; “After an application for payment is submitted, the contracting parties negotiate and eventually agree on an amount. The requisition is

then certified, and you the contractor can submit it to the owner for payment.”,
Paragraph 1, Page 217).

Regarding Claim 74 Primavera Expedition teaches a project management system and method further comprising securing the document collection via access rights (user security, login/password, etc.; reference A: Page 4; Bullet 9, Page 10; Page 23).

Regarding Claim 75 Primavera Expedition teaches a project management system and method wherein the project is a construction project (reference A: construction manager, general contractor; Pages 16-18).

Regarding Claims 76 and 78 Primavera Expedition teaches a project management system and method wherein the vendor's determination that approval for the project has been secured is effected by the vendor's review, electronically, of a purchase order (reference A: requisition/invoice/purchase order workflow/process, application and certification of payment, proceed orders; Pages 198-200, 212-213, 219-220; “Requisitions, or formal requests for payment, are usually issued by general contractors to the owner on a monthly basis as portions of the work on a project are completed....an application for payment based on the original requisition is updated, certified and sent.”, Paragraph 1, Page 198; application for payment, second figure on Page 201; “After an application for payment is submitted, the contracting parties

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negotiate and eventually agree on an amount. The requisition is then certified, and you the contractor can submit it to the owner for payment.”, Paragraph 1, Page 217; “Requisition Reports and Forms”, Total Stored to Date, Retainage, etc.; Page 218; “Recording Invoices”, Paragraph 1, Page 219; “Adding Invoices to a Purchase Order”, Paragraph 1, Page 220; “Viewing the Status of a Submittal”, Page 329;).

Regarding Claim 77 Primavera Expedition teaches a project management system and method wherein the vendor (general contractor, construction manager, etc.) accesses payment confirmation via the system/method (reference A: closing out purchase order using invoices, invoice report, submittal report, contract status; Pages 198, 212-213, 219-220, 418).

Regarding Claim 79 Primavera Expedition teaches a project management system and method wherein the purchase order is electronically issued to the vendor and a notification is made to the project manager (e.g. email to owner/construction manager, distribution lists, document routing; reference A: Pages 111, 178-179 184-185, 198, 204, 217).

Regarding Claim 80 Primavera Expedition teaches a project management system and method further comprising providing a contract to the vendor wherein the contract, as part of the project documentation, defines the tasks to be performed by the vendor (reference A: Pages 163, 177-178).

Regarding Claim 81 Primavera Expedition teaches a project management system and method wherein the contract provides for the issuance of change orders (reference A: Pages 227-243).

Regarding Claim 82 Primavera Expedition teaches a project management system and method further comprises providing a list of all projects associated with a particular user and providing access to project documentation for each project listed (e.g. selection tree, project files; reference A: Pages 12-13, 26).

Regarding Claim 84 Primavera Expedition teaches a project management system and method wherein the project is assigned a project number (project number, job number, etc.; reference A: "Items Overdue" table, Page 5; Paragraph 1, Page 21).

Regarding Claim 85 Primavera Expedition teaches a project management system and method wherein the funding approval is part of a client (owner) request (request for assistance, contract, requisition, submittal, bid, bid package, request for information, request for proposal, etc.; reference A: Pages 37, 129, 163, 177, 311).

Regarding Claim 86 Primavera Expedition teaches a project management system and method wherein the funding approval process is processed within the system by an approval process ("Process Overview", Page 198; "Certifying a

Requisition", Page 212; Paragraph 1, Page 213; "Approving Change Orders", Page 269; "Tracking Multiple Reviewers", Page 324; figure on Page 198).

Regarding Claim 87 Primavera Expedition teaches a project management system and method wherein the approval process includes a series of approvers (reference A: "Setting Up Distribution List", Page 33; Paragraph 1, Page 39; Paragraph 1, Page 173; Paragraph 2, Page 204; "Tracking Multiple Reviewers", Page 324; "Obtain approvals and certify", figure on page 198).

Regarding Claim 90 Primavera Expedition teaches a project management system and method further comprises soliciting work from the vendor (transmittals, submittals, contracts, negotiate, bids, RFPs, bid packages, proposals, etc.; reference A: Pages 39, 129, 292-298; 312-315; bid package, figure on Page 73; Paragraph 1, Page 251; "Collecting Proposals", Page 265; Paragraph 1, Page 298; Figures on Pages 77, 251, 258).

Regarding Claim 91 Primavera Expedition teaches a project management system and method wherein the vendor communicates with the system using a workstation over a network (email, LAN, WAN, etc.; reference A: "Email System", Page 115; "Sending or Dialing in a Request", Page 217).

Regarding Claim 93 Primavera Expedition teaches a project management system and method wherein the system provides for a user to access all funding documents for projects on which the user is involved (Expedition workspace, project tree, selection tree, etc.; "Setting Access Rights", Page 23; "Publishing reports on the World Wide Web", Page 417; figure on Page 12).

Regarding Claim 94 Primavera Expedition teaches a project management system and method further comprises providing an evaluation of an offer (bid, proposal, change order, submittal, etc.) extended by a vendor (submittals process, contract negotiation/changes; reference A: Pages 227-228; 292-298, 312-314, 324-325, 329).

Regarding Claim 95 Primavera Expedition teaches a project management system and method wherein the review entity is a project manager and the offer extended is a bid (reference A: Pages 227-228, 292-298, 312-314).

Regarding Claim 97 Primavera Expedition teaches a project management system and method wherein the vendor is a construction entity (reference A: Pages 16-18).

9. Claim 98 is rejected under 35 U.S.C. 102(e) as being anticipated by Casto, U.S. Patent No. 6,038,547.

Regarding Claim 98 Casto teaches a construction project management system and method comprising the coordination of work done on a project and the electronic receipt (applications for payment, invoices, requests for payments, AIAA G702/703 forms), review, approval and payment of project work completed by a plurality of vendors (contractors, subcontractors; Abstract; Column 2, Lines 65-68; Column 3, Lines 1-30).

More specifically Casto teaches a method and system for managing a project (work, effort, activity, initiative, product, service, etc.) comprising:

- establishing a database (Column 5, Lines 17-27);
- workstations (terminals, devices, handheld computers, etc.) connected via a network (Column 6, Lines 25-63);
- providing funding (financial) approval associated with a project wherein the approval is associated with one or more project documents (e.g. AIA G702/703, Application and Certificate for Payment) maintained in the system/database (Abstract; Figures 1-2B);
- vendor (contractor, subcontractor, supplier, business entity, user, etc.) access to the database (Column 4, Lines 11-33; Column 5, Lines 47-52);
- vendor submitting (entering, inputting, providing, uploading, sending, etc.) project information electronically (Column 5, Lines 46-54);

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- vendor determining that funding approval for the project has been secured (i.e. the project's funding has been approved) by accessing the project documents (e.g. receipt of AIA G702 – certificate of payment; Figures 2A-2B);

- transferring monetary funds to the vendor after a predetermined (predefined, agreed to) event has occurred (completion of a portion of a project, milestone, date, invoice, etc.; Column 6, Lines 20-24);

- the project is a construction project (Abstract; Title); and

- vendor (contractor, builder, subcontractor, etc.) is a construction entity

(Abstract).

Casto further teaches that the project management system and method utilizes a plurality of well known and widely used American Institute of Architects (AIA) documents (forms, processes, procedures) related to construction projects including but not limited to the following (Column 1, Lines 34-68; Column 2, Lines 1-63; Column 6, Lines 19-22; Figures 1-2B):

- AIA contractor form G702 Application for Payment, a form with which the contractor can apply for payment and the architect (project manager) can certify payment is due;

- AIA document G702 requires the contractor to show the status of the contract sum to date, including the total dollar amount of the work completed and stored to date, the amount of retainage (if any), the total of previous payments, a summary of change orders and the amount of current payment requested; and

- AIA contractor form G703 Continuation Sheet for G702 breaks the contract sum into portions of the work in accordance with a schedule of values required by the general conditions. It serves as both the contractor's application and the architect's (project managers) certification, and its use can expedite payment and reduce the possibility of error. If the G703 Continuation Sheet application is properly completed and acceptable to the architect, the architect's signature certifies to the owner (business, client, etc.) that a payment in the amount indicated is due to the contractor (vendor, subcontractor, etc.). The form also allows the architect to certify an amount different than the amount applied for when the architect provides explanation.

Casto further teaches a method and system for managing a construction project further comprising:

- upon the completion of a portion of a project (milestone, predetermined event, deliverable, work, etc.) the vendor submits an invoice electronically (e.g. AIA G702/703; Column 5, Lines 46-68; Column 6, Lines 1-24; Figures 1-2B);

- payment of the invoice (certification, approval) goes through a validation (approval, verification, review, etc.) process against portions of a project contract (agreement, project plan, plan, etc.; Column 2, Lines 1-3; Column 5, Lines 46-68; Column 6, Lines 1-14);

- enabling users to "log on" and utilizes well known technologies including but not limited to SHTTP (secure hyper text protocol), database management systems (Oracle, Sybase) and Java Column 5, Lines 20-35; Column 6, Lines 31-35);

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- vendor approval determination is based on the vendor's review of a purchase order (e.g. Application and Certification of Payment, AIA G702/703) stored as part of the project documentation (Column 5, Lines 46-68; Column 6, Lines 1-25; Figures 2A-2B);

- purchase order is issued electronically (Column 5, Lines 46-68);

- providing a contract to a vendor, as part of the project's documentation, wherein the contract defines tasks to be performed by the vendor (Column 1, Lines 34-55; Column 5, Lines 36-68; Column 6, Lines 1-12);

- a contract (agreement, statement of work, work orders, plan, etc.) that provides for the issuance of change orders by a project manager (e.g. changes to G703; Column 1, Lines 55-65; Column 3, Lines 27-31; Figure 2);

- obtaining an invoice (request for payment, bill; AIA G702) from each builder (vendor, contractor, subcontractor, etc.) once the builder's respective portion of the project is completed (Column 3, Lines 19-23; Column 5, Lines 26-54);

- soliciting work from vendors (request for quote, request for proposal, bids, bidding process, etc.; Column 4, Lines 26-32); and

- the project information can be associated (segmented, aggregated, presented, listed, grouped, etc.) by project, region, contractor/subcontractor (vendor) or the like (Column 3, Lines 5-31).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 88-89, 96 and 103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Primavera System, Inc.'s Primavera Expedition as disclosed in at least the following Primavera Expedition Version 6.0 User's Guide (1998), herein after reference A, as applied to claims 68-87, 90-91, 93-95 and 97 above and further in view of Schuyler et al., U.S. Patent No. 6,832,202.

Regarding Claims 88-89 Primavera Expedition teaches a project management system and method comprising a workflow subsystem/component for managing project document collections (contracts, purchase orders, submittals, etc.) including managing the submission, review and approval of those documents as well as changes to those documents as part of a customized workflow/process (reference A: Pages 9, 227-228, 247-248, 269, 324).

Primavera Expedition does not expressly teach that the approver returns the approval to a previous approver who is not the requestor or the approver returns the approval to a previous approver and the requestor as claimed.

Schuyler et al. teach an approval method/system wherein funding requests/approvals are processed via a request for authorization workflow in an analogous art of project administration and management, the system/method comprises:

- a series (successive) of approvers (Column 1, Lines 55-68; Column 4, Lines 60-65);
- returning funding approval to a previous approver who is not the requester (Column 8, Lines 39-68; Figures 2A-2B); and
- returning funding approvals to the requestor and previous approver (Column 8, Lines 39-68);

for the purposes of improving the approval process (workflow) by automating manual tasks (Column 1, Lines 40-45).

More generally Schuyler et al. teach a system and method for routing requests for authorizations (e.g. approval for funding, expenses, applications, work assignments, etc.) wherein the approval process is defined as a workflow. Schuyler et al. teach requests for approvals are routed based on an approval process/rules that include but is not limited to a series of approvers, hierarchy of approvers (Column 1, Lines 28-32), contract rules (Column 1, Lines 58-62; Abstract; Column 1, Lines 55-68; Column 2, Lines 6-36; Column 3, Lines 59-68; Figures 2A-2B) and automatically notifies/forwards approval requests/approvals as well as approval status information to the appropriate users (Column 8, Lines 45-48) and enables users to access approval information over a computer network (Column 7, Lines 38-42).

Schuyler et al. teach that the system and method for managing requests for approvals stores a plurality of documents associated with each request in a database (Column 5, Lines 6-62; Figure 1), provides user notification of request status (rejection, acceptance, etc.; Column 7, Lines 27-32; Column 8, Lines 42-49; Column 10, Lines 10-12) and enables users to access approval information over a computer network (Column 7, Lines 38-42).

It would have been obvious to one skilled in the art at the time of the invention that the construction project management system and method, with its utilization of a customized workflow process for managing the receipt, review, approval and payment related to a collection of project documents (submittals, invoices, contracts, requisition, purchase orders, etc.) as taught by Primavera Expedition would have benefited from routing/returning approvals/reviews to previous approvers and/or the requestor (a series of approvers/reviewers) based on a plurality of rules (contract, monetary, hierarchy, etc.) in view of the teachings of Schuyler et al.; the resultant system providing a substantially automated and robust funding approval process (Schuyler et al.: Column 1, Lines 40-45).

Regarding Claim 96 Primavera Expedition teaches a customizable, multiple reviewer, multi-stage workflow to manage the submission, receipt, review and approval of a plurality of project documents, as discussed above, Primavera Expedition does not

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expressly that the project funding approval is effected by client (business) hierarchy as claimed.

Schuyler et al. teach that an organization hierarchy effects funding approval, in an analogous art of project administration and management, for the purposes of routing the approval to the appropriate reviewer/approver of the funding request who is at an appropriate (desired, required) level in the organization (hierarchy; Column 1, Lines 28-32 and 61-64).

It would have been obvious to one skilled in the art at the time of the invention that the construction project management system and method, with its customized project documentation workflow, as taught by Primavera Expedition would have benefited from effecting the approval of one or more of the project documents (e.g. funding/payment approval for a requisition, invoice, purchase order, etc.) by a client hierarchy in view of the teachings of Schuyler et al.; the resultant system enabling users to route approvals to the appropriate reviewer/approver of the funding request who is at an appropriate (desired, required) level in the organization (hierarchy; Column 1, Lines 28-32 and 61-64).

Regarding Claim 103, Claim 103 recites similar limitations to Claims 68-70, 74, 80, 87, 94 and 96 and is therefore rejected using the same art and rationale as applied in the rejection of Claims 68-70, 74, 80, 87, 94 and 96.

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12. Claim 92 is rejected under 35 U.S.C. 103(a) as being unpatentable over Primavera System, Inc.'s Primavera Expedition as disclosed in at least Primavera Expedition Version 6.0 User's Guide (1998), herein after reference A, as applied to claims 68-87, 90-91, 93-95 and 97 above and further in view of DeFrancesco et al., U.S. Patent No. 6,505,176.

Regarding Claim 92 Primavera Expedition teaches a project management system and method as discussed above.

While Primavera Expedition teaches tracking the status of a plurality of project documents associated with various contacts/businesses (e.g. tracking submittal status; Page 329) Primavera Expedition does not expressly providing a list of request for assistances associated with a particular business unit as claimed.

DeFrancesco et al. teach providing users with a list of pending funding applications (requests for assistance) associated with a plurality of workgroups (business units, workgroup queue; Column 3, Lines 40-60; Column 7, Lines 28-36), in an analogous art of managing funding approvals, for the purposes of automatically coordinating the request for assistance/funding (loans, mortgages, credit, etc.) workflow amongst a plurality of businesses entities (workgroups; Column 1, Lines 15-37 and 65-68; Column 2, Lines 1-12).

More generally DeFrancesco et al. a workflow system and method for managing the funding approval process/workflow over a network wherein the funding request comprises a collection of documents, stored in a database (Column 4, Lines 1-10), that are routed based on a plurality of rules to a plurality of workgroups (divisions, groups, teams, etc.) for processing (particular set of functions/tasks; Abstract; Column 3, Lines 30-60). DeFrancesco et al. further teach that the funding approval system and method notifies users with respect to the funding approval process/workflow including notifying users of such things as steps completed, in-progress, are next and the like (Column 5, Lines 57-66) as well as returns approvals/requests to the previous approve and/or requestor as required (Column 7, Lines 47-54).

It would have been obvious to one skilled in the art at the time of the invention that the system and method for project management as taught by Primavera Expedition would have benefited from providing a users a list of the currently active (in process, pending, etc.) requests for assistance associated with a particular business unit (workgroup) in view of the teachings of DeFrancesco et al.; the resultant system enabling users to manage/coordinate the approval of requests for assistances (funding/credit requests) amongst a plurality of business entities (DeFrancesco et al.: Abstract).

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13. Claim 99 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyt et al., U.S. Patent No. 6,067,531.

Regarding Claim 99 Hoyt et al. teach a computer-implemented method for managing a project using a processing system, the system/method comprising ("A contract system automates negotiation and generation of contract documents by managing the workflow in a contract approval process.", Abstract):

- establishing a database in the system, the system being maintained by a project management entity (business, person, etc.; "Multiple users coupled by a computer network, access a contract database containing multiple contracts", Abstract; Column 2, Lines 13-17; Figure 1, Element 109; Figure 4, Element 412);

- providing funding approval (signed/awarded contract) associated with the project, the funding being effected in association with a document collection associated with the project, the document collection maintained in the database (Column 8, Lines 1-20);

- accessing the document collection in the database by a vendor (i.e. the vendor is the project management entity which is preparing a contract for a customer's approval/execution; Column 2, Lines 13-37; Column 7, Lines 34-65);

- the vendor entering and submitting electronically information related to the project (Column 7, Lines 34-65; Column 8, Lines 1-20; Figures 6, 14); and

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- the vendor determining that approval for the project has been secured through access to the system ("signed'-external" status; Column 8, Lines 1-20; Column 15, Lines 41-46; Column 16, Lines 1-15; Figure 4, Element 422; Figure 6).

Hoyt et al. further teaches that the computer-implemented project management method comprises:

- multiple level/role-based security (access control to system and documents contained therein; Column 7, Lines 33-40; Column 13; Lines 57-65);
- the approval process is executed by a series of hierarchically arranged approvers/reviewers (Column 7, Lines 34-66; Column 8, Lines 1-20; "User_Hierarchy Table", Columns 9-10; Figures 4A-4B); and
- provides each user with a list of the projects (contracts) they are assigned to and provides the data set/document collection associated with each listed project (Column 7, Lines 33-43).

Hoyt et al. does not expressly teach transferring monetary funds to the vendor after a predetermined event has occurred as claimed.

Official notice is taken that it is a common and widely practice business practice to pay for services rendered. More specifically it is old and well known to transfer monetary funds to vendors (contractors, suppliers, subcontractors, etc.) upon the completion of project milestones, time frames or work progress.

It would have been obvious to one skilled in the art at the time of the invention that the computer-implemented project management method as taught by Hoyt et al. would have benefited from the common business practice of paying for services rendered (work completed) in view of the teachings of official notice.

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14. Claims 100 and 102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owen, David, Facilities Management & Relocation (1993) in view of Primavera System, Inc.'s Primavera Expedition system/product as disclosed in at least the following Primavera Expedition Version 6.0 User's Guide (1998), herein after reference A.

Regarding Claims 100 and 102 Owen teaches a method for managing a project (construction and relocation projects) comprising:

- establishing a document collection (repository, data set, etc.) to store (save, archive, etc.) project documents, document collections and project data by a project management entity (construction documents, master forms; Numbers 21-34; Pages 124-125; Master Forms, Pages 359, 361-362);

- providing funding approval associated with the project, the funding approval being effected in association with a document collection associated with the project (change order approval, Figure 8.2; field order, Paragraph 5, Page 210; Number 24, Page 125; final budget, Page 137; Figure 4.5);

- accessing the document collection by a vendor (last Paragraph, Page 201; Paragraph 3, Page 204);

- the vendor entering and submitting information related to the project (number 28, Page 125; Last Paragraph, Page 199; Paragraphs 1-2, Page 200);

- the vendor determining that approval for the project has been secured (number 34, Page 126; hold backs, last two Paragraphs, Page 217; purchase orders, final cost settlement, Page 241; Figure 4.5); and
- transferring monetary funds to the vendor after completion of a portion of the project associated with the vendor (monthly payment draw, Paragraph 2, Page 204; Bullet 7, Page 207; hold backs, last two Paragraphs, Page 217; final cost settlement, Page 241).

Owen does not expressly teach that the project management method is implemented on a computer or subsequently the establishing, storing and/or maintaining a database comprising project documentation or the vendor submitting project information electronically as claimed.

Primavera Expedition teaches a computer-implemented project management method wherein a project management entity establishes a project document collection database (construction manager, general contract, owner, etc.; reference A: Pages 16-18; e.g. Sybase; Bullet 10, Page 10; Pages 93-97);

- providing funding approval associated with the project, the funding approval being associated effected in association with project documentation contained in the database (e.g. approved revisions/change orders, initial/committed budget, invoice/requisition approval, negotiated, etc.; reference A: Paragraph 3, Page 16; Bullet 6, Pages 168, 173, 198; Step 5, Page 199; Paragraph 2, Page 204; Pages 212-213);

- accessing the document collection by a vendor over a network (supplier, contractor, partner, general contractors, construction managers, etc.; reference A: Pages 16-18);

- vendor entering/submitting information related to the project electronically (invoices, requisitions, purchase orders, change orders, submittals, etc.; reference A: Pages 177-179, 198); and

- vendor determining that funding approval for the project has been secured through access to the document collection (e.g. submit/track submittals, proceed orders, committed, actuals, pending, changes, etc.; reference A: Page 6-8, 163-166, 181; "Funding", Bullet 5, Page 165; "reviewing contract status", Page 188)

in an analogous art of project management for the purposes of making it easier to manage/control projects and the projects associated document collections (Page ix).

It would have been obvious to one skilled in the art at the time of the invention that the project management method as taught by Owen would have benefited from automating the project management method using a computer, establishing a project document collection database and enabling users (vendors) to submit project information electronically in view of the teachings of Primavera Expedition; the resultant system/method making it easier to manage/control projects and the projects associated document collections (Primavera Expedition: Page ix).

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Furthermore, it is well settled that it is not "invention" to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result. In re Venner, 120 USPQ 192.

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15. Claims 101 and 104 are rejected under 35 U.S.C. 103(a) as being unpatentable over Primavera System, Inc.'s Primavera Expedition as disclosed in at least the following Primavera Expedition Version 6.0 User's Guide (1998), herein after reference A, in view of Hoyt et al., U.S. Patent No. 6,067,531.

Regarding Claim 101 Primavera Expedition teaches a project management system and method comprising:

- establishing a database maintained by a project management entity (construction manager, general contract, owner, etc.; reference A: Pages 16-18; e.g. Sybase; reference A: Pages xiv, 4; Bullet 10, Page 10);
- providing funding approval associated with the project, the approval being effected in association with a project document collection maintained in the database wherein the funding approval comprises (e.g. approved revisions/change orders, initial/committed budget, invoice/requisition approval, negotiated, etc.; reference A: "Invoices/Requisitions are generated from contracts/POs, then sent for payment approval. The amounts are posted on the Cost Worksheet to track actual costs", Paragraph 4, Page 6; Paragraph 3, Page 16; "Approving Requisitions: Preparing Requisitions for Payment chapter.", Bullet 6; Page 18; "You can easily track submittal review cycles.... which submittals where approved and which are pending", Paragraph 1, Page 39; Bullets 1-2 and 5, Page 165; "Change management is a workflow process that automatically creates the documents necessary to track a change from the initial request through approval.", Paragraph 1, Page 173; Step 5, Page 199; Paragraph 2,

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Page 204; Pages 212-213; "Type the date the contract was signed"; figure caption, Page 21; contract acceptance field, figure on Page 37; document status – approved as noted, approved, disapproved, etc., first figure on Page 78; action taken section on transmittal form – approved as submitted, approved as noted, etc.; Page 133);

- series of approvers, multiple review stages hierarchy (workflow, steps, identities; reference A: "Setting Up Distribution List", Page 33; Paragraph 1, Page 39; Paragraph 1, Page 173; Paragraph 2, Page 204; "Tracking Multiple Reviewers", Page 324; "Obtain approvals and certify", figure on page 198);

- automatically forwarding a notice requesting the approval of at least one electronic document to a successive one of the entities upon approval of at least one document by a previous entity review/approval process (document routing, change management, distribution lists, multiple reviewers, etc.; reference A: 132, 312, 321, 324-325; "Setting Up Distribution List", Page 33; Paragraph 1, Page 39; Paragraph 1, Page 173; Paragraph 2, Page 204; "Tracking Multiple Reviewers", Page 324; "Obtain approvals and certify", figure on page 198).);

- vendor accessing the project documentation collection (supplier, contractor, partner, etc.; .; reference A: "As the general contractor you'll use Expedition to manage shop drawings and submittal items, track project issues, document the change process and record daily progress.", Paragraph 3, Page 16; Pages 16-18; group roles – construction manager, architect, engineer, contractor, subcontractor, supplier, etc.; Paragraph 1, Page 77);

- vendor (contractor, subcontractor, supplier, manufacturer, etc.)
entering/submitting information related to the project electronically (invoices, requisitions, purchase orders, change orders, submittals, etc.; reference A: Pages 177-179, 198; "Requisitions, or formal requests for payment, are usually issued by general contractors to the owner on a monthly basis as portions of the work on a project are completed....an application for payment based on the original requisition is updated, certified and sent.", Paragraph 1, Page 198; application for payment, second figure on Page 201; "After an application for payment is submitted, the contracting parties negotiate and eventually agree on an amount. The requisition is then certified, and you the contractor can submit it to the owner for payment.", Paragraph 1, Page 217); and
- vendor determining that funding approval for the project has been secured through access to the document collection (e.g. submit/track submittals, proceed orders, committed, actuals, pending, changes, etc.; reference A: "After participants accept a contract or purchase order and work begins, any changes resulting from changed specifications or changed conditions affect the initial contract.", Last Paragraph, Page 6; Page 6-8, 163-166, 181; "Funding", Bullet 5, Page 165; "reviewing contract status", Page 188; "Requisitions are based on contract or purchase order...parallel industry standard AIA G702/703 certification payment forms....You negotiate the line item or lump sum costs until a payment agreement is reached and the requisition is approved and certified.", Last Paragraph, Page 198; "Depending on your role, you may issue payment requests or receive payment requests. For example, if you are a general contractor you receive payment requisitions from subcontractors and you issue

requisitions to owners.”, Paragraph 1, Page 199; Figure, Page 200; “All applicable parties approve the requisition.”, Paragraph 2, Page 204; “Certifying a Requisition”, Page 212).

Primavera Expedition does not expressly teach identifying an approval hierarchy as claimed.

Hoyt et al. teach approval process is executed by a series of hierarchically arranged approvers/reviewers (Column 7, Lines 34-66; Column 8, Lines 1-20; “User_Hierarchy Table”, Columns 9-10; Figures 4A-4B) in an analogous art of project management and/or document approval for the purposes of enabling multiple hierarchical levels/classes of users review, revise and approve/accept one or more documents/projects/contracts for approval until all the reviewers are satisfied/accept the document (Column 8, Lines 1-15).

More generally Hoyt et al. teach a computer-implemented method for managing a project using a processing system, the system/method comprising (“A contract system automates negotiation and generation of contract documents by managing the workflow in a contract approval process.”, Abstract):

- establishing a database in the system, the system being maintained by a project management entity (business, person, etc.; “Multiple users coupled by a computer network, access a contract database containing multiple contracts”, Abstract; Column 2, Lines 13-17; Figure 1, Element 109; Figure 4, Element 412);

- providing funding approval (signed/awarded contract) associated with the project, the funding being effected in association with a document collection associated with the project, the document collection maintained in the database (Column 8, Lines 1-20);

- accessing the document collection in the database by a vendor (i.e. the vendor is the project management entity which is preparing a contract for a customer's approval/execution; Column 2, Lines 13-37; Column 7, Lines 34-65);

- the vendor entering and submitting electronically information related to the project (Column 7, Lines 34-65; Column 8, Lines 1-20; Figures 6, 14); and

- the vendor determining that approval for the project has been secured through access to the system ("signed'-external" status; Column 8, Lines 1-20; Column 15, Lines 41-46; Column 16, Lines 1-15; Figure 4, Element 422; Figure 6).

Hoyt et al. further teaches that the computer-implemented project management method comprises:

- multiple level role base security (access control to system and documents contained therein; Column 7, Lines 33-40; Column 13; Lines 57-65);

- the approval process is executed by a series of hierarchically arranged approvers/reviewers (Column 7, Lines 34-66; Column 8, Lines 1-20; "User_Hierarchy Table", Columns 9-10; Figures 4A-4B); and

- provides each user with a list of the projects (contracts) they are assigned to and provides the data set/document collection associated with each listed project (Column 7, Lines 33-43).

It would have been obvious to one skilled in the art at the time of the invention that the construction project management system and method, with its custom multi-stage/multiple reviewer workflow for managing the submission, receipt, review, approval and payment for completed work, as taught by Primavera Expedition would have benefited from identifying an approval hierarchy in view of the teachings of Hoyt et al.; enabling multiple hierarchical levels/classes of users review, revise and approve/accept one or more documents/projects/contracts for approval until all the reviewers are satisfied/accept the document (Hoyt et al.: Column 8, Lines 1-15).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Ivanov, Vladimir, U.S. Patent No. 5,706,452, teaches a system and method for managing the approval process associated with one or more documents using well-known workflow techniques and technologies.

- Knudson et al., U.S. Patent No. 5,765,140, teach a project management system and method for managing and tracking a plurality of data (data sets) as well as project funding sources and funding progress associated with projects wherein the system/method comprises request for assistance(s) associated with things such as capital projects.

- Mosig, Richard, Software review (1996) teaches a plurality of project management systems and methods for managing construction projects wherein the systems/methods include document repositories (contracts, applications for payment, change orders, punch lists, submittals, proposals, etc. stored in one or more database), and support project bidding.

- Larsen, Amy, Internet goes to Work for Builders (1998) teaches the commercial availability and use of a computer-implemented construction project management method comprising document repository and workflow engines (subsystems).

- Fusaro, Roberta, Builders Moving to Web Tools (1998) teaches a web-based construction project management system and method which supports "everything from design through billing by supplying a collaboration and workflow management system

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specifically crafted for construction projects.” More specifically Fusaro teaches that the system/method enables users to review/process requests for assistance (e.g. request for information, bids, etc.).

- Deckmyn, Dominique, San Francisco manages \$45m project via web-based service (1999) teaches the use of a secure web-based construction project management system and method for managing a plurality of documents/data associated with one or more construction projects wherein a plurality of construction project team members (project management, contractors, owners, vendor, etc.) access, submit and review the plurality of project documents/data stored in the database/system. Deckmyn further teaches that these systems support user-level/role-based security and provide users with personalized access to the project documents/data they are assigned to/associated with.

- Primavera Systems Delivers Expedition Express (1999) teaches an online system and method for project management wherein the system/method enables project managers, contractors/vendors/subcontractors, owners and the like to securely access, submit and review a plurality of documents/data associated with the project. The article further teaches that “users get a personalized to-do list of items requiring immediate attention, such as open RFIs, correspondence, daily progress reports – ensuring timely responses from even the most remote members of the project team.”

- Hernandez et al., Software solutions (1999) teaches several commercially available computer-implemented construction project management methods wherein

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the methods/systems enable users to securely access, submit and respond to request for assistances (RFIs, change orders, etc.).

- Seibert, Paul, Facilities Planning & Design for Financial Institutions (1996) teaches well known techniques/methods (forms, checklists, etc.), used by financial institutions and others, for the planning of facilities including construction and relocation management as well as facility management.

- Cotts, David, The Facility Management Handbook (1998) teaches well known methods and techniques for facility management including project management of construction projects.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott L. Jarrett whose telephone number is (571) 272-7033. The examiner can normally be reached on Monday-Friday, 8:00AM - 5:00PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hafiz Tariq can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SJ

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